

**T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT**

Date:	<input type="text" value="29-Jun-07"/>	APPL. S. N:	<input type="text" value="10616366"/>
To Examiner:	<input type="text" value="TABATABAI, ABOLFAZI"/>	Art Unit	<input type="text" value="2624"/>
From	<input type="text" value="Gunter-Riley, Joyce"/> PARALEGAL SPCECIALIST	Return This Memo To: Case Drop-Off Location	<input type="text" value="JEF-2D68"/>

**SUBJECT:** Decision on Terminal Disclaimer(T.D.) filed:

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete,


please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see 14.24):
- ☐ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see 14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see 14.27.01).
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see 14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney "of record" (see 14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see 14.28).
    - ☐ is not recognized as an officer of the assignee (see 14.29 & possible 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see 14.30).
  - ☐ The T.D. is not signed (see 14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see 14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see 14.26, 14.27.02 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see 14.26, 14.27.02 or 14.26.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex.Initials: \_\_\_\_\_ Date: \_\_\_\_\_

Log Date: \_\_\_\_\_

<b>Application Number</b> 	<b>Application/Control No.</b> 10/616,366	<b>Applicant(s)/Patent under Reexamination</b> BRUCE ET AL.	

<b>Document Code - DISQ</b>	<b>Internal Document – DO NOT MAIL</b>
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<b>TERMINAL DISCLAIMER</b>	<input checked="" type="checkbox"/> <b>APPROVED</b>	<input type="checkbox"/> <b>DISAPPROVED</b>
Date Filed : May 29, 2007	This patent is subject to a Terminal Disclaimer	

<b>Approved/Disapproved by:</b>
Henry D. Jefferson

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Patent Application  
Attorney Docket No. A2247-US-CIP  
(XERZ 2 2 00563-3)

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MAY 29 2007

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

In re Application of: **Richard Bruce, et al.**

Application No.: **10/616,388**

Group Art Unit: **2621**

Filed: **July 09, 2003**

Examiner: **Tabatabai**

For: **APPARATUS AND METHOD FOR DETECTING AND LOCATING RARE CELLS**

The owner, Xerox Corporation, of 100% percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer of prior Patent No. 7,113,624. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

☒ The undersigned is an attorney or agent of record.

May 29, 2007  
Date

Sue Ellen Phillips  
Signature

FAY SHARPE LLP  
1100 Superior Avenue, Seventh Floor  
Cleveland, Ohio 44114-2579

Sue Ellen Phillips  
Typed or Printed Name

32,046  
Registration No.

**Certificate of Mailing or Transmission**

I hereby certify that this correspondence, and any item referred to herein as being attached or enclosed, are being transmitted to the U.S. Patent and Trademark Office by facsimile in accordance with 37 CFR 1.18 to Centralized Facsimile No. 571-273-8300 on the date indicated below.

May 29, 2007  
Date

Mary M. Schriener  
By: Mary M. Schriener

☒ Please charge \$130 to Deposit Account No. 24-0037 for the terminal disclaimer fee under 37 CFR 1.20(d). (An additional copy of this paper is enclosed.)

05/31/2007 EMAIL 00000025 240037 10616366  
01 FC:1051 130.00 DA

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Patent Application  
Attorney Docket No. A2247-US-CIP  
(XERZ 2 2 00563-3)

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MAY 29 2007

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

In re Application of: **Richard Bruce, et al.**

Application No.: **10/616,368**

Group Art Unit: **2621**

Filed: **July 09, 2003**

Examiner: **Tabatabai**

For: **APPARATUS AND METHOD FOR DETECTING AND LOCATING RARE CELLS**

The owner, Xerox Corporation, of 100% percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer of prior Patent No. 7,113,624. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

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☒ The undersigned is an attorney or agent of record.

Date

May 29, 2007

Signature

Sue Ellen Phillips

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1100 Superior Avenue, Seventh Floor  
Cleveland, Ohio 44114-2579

Sue Ellen Phillips

Typed or Printed Name

32 046

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Date

May 29, 2007

By: Maryl M. Schriener

☒ Please charge \$130 to Deposit Account No. 24-0037 for the terminal disclaimer fee under 37 CFR 1.20(e). (An additional copy of this paper is enclosed.)

05/19/2007 SFELEKE1 00000050 240037 10616366

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06/19/2007 SFELEKE1 00000050 10616366

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05/31/2007 EHAILEY 00000025 240037 10616366

01 FC:1851 130.00 DA

Adjustment date: 05/19/2007 SFELEKE1  
05/31/2007 EHAILEY 00000025 240037 10616366  
01 FC:1051 130.00 CR

**XEROX®**Dianne Ayers  
Patent Financial & Trademark Coordinator

VIA FACSIMILE: 571-273-6500

June 5, 2007

Honorable Commissioner of Patents and Trademarks  
Office of Finance  
Refund Division  
Box 17  
Washington, D. C. 20231

To Whom It May Concern:

The following item was incorrectly debited to our May 2007 account statement for 24-0037:

Serial No.	Date Posted	Control No.	Amount	Type
10/616,366	5/31	36	\$130	D

Our deposit account was charged for a Surcharge for late filing fee or oath or declaration - fee code 1051. However, this is incorrect. Our outside counsel submitted a terminal disclaimer in May 2007. The fee code charged should have been 1814. Therefore, please credit our deposit account in the amount of \$130 to reimburse us for the incorrect charge and properly debit for the fee code 1814 for the Terminal Disclaimer submitted.

Thank you for your attention to this matter.

Very truly yours,

  
Dianne AyersXerox Corporation  
100 South Clinton Avenue  
Xerox Square - 20A  
Rochester, NY 14644  
Telephone 585-423-6998  
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